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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/828,252

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Daniel M. Schwartz

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12/09/2005

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EXAMINER

CAMPBELL, JOSHUA D

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 12/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/828,252

Applicant(s)

SCHWARTZ ET AL.

Examiner

Joshua D. Campbell

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to communications: Amendment filed 10/24/2005.
2. Claims 1-22 are pending in this case. Claims 1, 11, 15, and 16 are independent claims. Claims 1, 11, 15, 16, and 18-22 have been amended.
3. The rejection of claims 1-22 under 35 U.S.C. 103(a) as being unpatentable over McCurdy et al. (hereinafter McCurdy, US filing date June 30, 2000) in view of Hearst et al. (hereinafter Hearst, issued October 2, 2001) has been withdrawn due to amendments.

### ***Claim Objections***

4. Claim 18 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The additional limitation provided by claim 18 is that "...the display screen is oriented in a landscape format," which is already a limitation in claim 11. Proper correction is required.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCurdy et al. (hereinafter McCurdy, US filing date June 30, 2000) in view of Hearst et al. (hereinafter Hearst, issued October 2, 2001) further in view of Berstis (US Patent Number 5,978,819, issued November 2, 1999).

**Regarding independent claim 1,** McCurdy discloses a method in which a plurality of pages is laid out such that each page fully fits a display and the pages are combined to form one single document (page 2, paragraph 0014, page 15, paragraphs 0200 and 0203). A navigation bar is used to perform a plurality of functions dealing with navigating using an electronic pointing device (Figures 14 and 15 of McCurdy). The digital magazine is then electronically distributed to a plurality of subscribers (page 13, paragraph 0185). McCurdy does not disclose a method in which the navigation bar is inserted into the pages and stored as a part of the pages. However, Hearst discloses a method in which an electronic book or magazine has a navigation bar inserted into it

and stored as a part of the collection of pages which includes at least one digital file, so that the navigation bar is viewable when viewing each of the pages (column 4, lines 6-60 of Hearst). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of McCurdy with the method of Hearst because it would have made the file more portable, allowing the navigation to be controlled by the document being viewed and not a specific browser.

Neither McCurdy nor Hearst disclose that single pages are laid out in a manner that fills a full-screen display. However, Berstis discloses a method in which a compound document may be selectively reflowed in order to fit a display screen or window (column 2, lines 20-64 of Berstis). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of McCurdy and Hearst with the teachings of Berstis because it would have improved the readability of the document based on the size of the display.

**Regarding dependent claim 2,** McCurdy discloses a method in which the magazine may be transmitted as an attachment to an e-mail message (page 23, paragraph 0348 of McCurdy).

**Regarding dependent claims 3 and 4,** McCurdy discloses a method in which the magazine may be stored at URL that is linked to in order to download (paragraph 0348 of McCurdy). McCurdy does not explicitly say that the URL would be emailed to users to access the document. However, McCurdy does disclose that subscriber may wish to be e-mailed when a new issue is available and since that issue may be accessed using a link to a URL (website), as disclosed by McCurdy (page 13,

paragraph 0185 and page 23, paragraph 0348 of McCurdy), it would have been obvious to one of ordinary skill in the art at the time the invention was made that the URL link itself would have been e-mailed to the user because it would have required less data to have been transmitted in the e-mail message as opposed to transmitting the entire document.

**Regarding dependent claim 5,** McCurdy discloses a method in which the files obtained correspond to a print magazine and the portions of the file that appear across two facing pages are recombined, reformatted, and repositioned to appear on the display screen as a single page of the digital magazine (page 1, paragraph 0009, page 2, paragraph 0013, and page 15, paragraph 0203 of McCurdy).

**Regarding dependent claims 6 and 7,** McCurdy discloses a method in which the display screen may show the magazine in portrait format or be rotated to show it in landscape format (pages 14-15, paragraphs 0199-0200 of McCurdy).

**Regarding dependent claim 8,** McCurdy discloses a method in which an audio or video clip may be programmed into the digital magazine (page 2, paragraph 0011 of McCurdy).

**Regarding dependent claims 9 and 10,** McCurdy discloses a method in which a template is used to lay out the areas of the pages and that the document is stored in a compressed Portable Document Format (page 2, paragraph 0018 and page 24, paragraph 0372 of McCurdy).

**Regarding independent claim 11,** McCurdy discloses a method in which a plurality of pages is laid out such that each page fully fits a display and the pages are

combined to form one single document (page 2, paragraph 0014, page 15, paragraphs 0200 and 0203). A navigation bar is used to perform a plurality of functions dealing with navigating using an electronic pointing device (Figures 14 and 15 of McCurdy). The digital magazine is then electronically distributed to a plurality of subscribers (page 13, paragraph 0185). McCurdy discloses a method in which the files obtained correspond to a print magazine and the portions of the file that appear across two facing pages are recombined, reformatted, and repositioned to appear on the display screen as a single page of the digital magazine (page 1, paragraph 0009, page 2, paragraph 0013, and page 15, paragraph 0203 of McCurdy). McCurdy also discloses a method in which the display screen may show the magazine in portrait format or be rotated to show it in landscape format (pages 14-15, paragraphs 0199-0200 of McCurdy). McCurdy does not disclose a method in which the navigation bar is inserted into the pages and stored as a part of the pages. However, Hearst discloses a method in which an electronic book or magazine has a navigation bar inserted into it and stored as a part of the collection of pages which include at least one digital file, so that the navigation bar is viewable when viewing each of the pages (column 4, lines 6-60 of Hearst). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of McCurdy with the method of Hearst because it would have made the file more portable, allowing the navigation to be controlled by the document being viewed and not a specific browser.

Neither McCurdy nor Hearst disclose that single pages are laid out in a manner that fills a full-screen display. However, Berstis discloses a method in which a

compound document may be selectively reflowed in order to fit a display screen or window (column 2, lines 20-64 of Berstis). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of McCurdy and Hearst with the teachings of Berstis because it would have improved the readability of the document based on the size of the display.

**Regarding dependent claims 12-14**, the claims incorporate substantially similar subject matter as claims 2-4. Thus, the claims are rejected along the same rationale as claims 2-4.

**Regarding independent claim 15**, McCurdy discloses a method in which the magazine may be transmitted as an attachment to an e-mail message (page 23, paragraph 0348 of McCurdy). McCurdy also discloses a method in which the magazine may be stored at URL that is linked to in order to download (paragraph 0348 of McCurdy). McCurdy does not explicitly say that the URL would be emailed to users to access the document. However, McCurdy does disclose that subscriber may wish to be e-mailed when a new issue is available and since that issue may be accessed using a link to a URL (website), as disclosed by McCurdy (page 13, paragraph 0185 and page 23, paragraph 0348 of McCurdy), it would have been obvious to one of ordinary skill in the art at the time the invention was made that the URL link itself would have been e-mailed to the user because it would have required less data to have been transmitted in the e-mail message as opposed to transmitting the entire document. McCurdy does not disclose a method in which the navigation bar is inserted into the pages and stored as a part of the pages. However, Hearst discloses a method in which an electronic book or



magazine has a navigation bar inserted into it and stored as a part of the collection of pages which includes at least one digital file, so that the navigation bar is viewable when viewing each of the pages (column 4, lines 6-60 of Hearst). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of McCurdy with the method of Hearst because it would have made the file more portable, allowing the navigation to be controlled by the document being viewed and not a specific browser.

Neither McCurdy nor Hearst disclose that single pages are laid out in a manner that fills a full-screen display. However, Berstis discloses a method in which a compound document may be selectively reflowed in order to fit a display screen or window (column 2, lines 20-64 of Berstis). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of McCurdy and Hearst with the teachings of Berstis because it would have improved the readability of the document based on the size of the display.

**Regarding independent claim 16,** McCurdy discloses a method in which a plurality of pages is laid out such that each page fully fits a display and the pages are combined to form one single document (page 2, paragraph 0014, page 15, paragraphs 0200 and 0203). A navigation bar is used to perform a plurality of functions dealing with navigating using an electronic pointing device (Figures 14 and 15 of McCurdy). The digital magazine is then electronically distributed to a plurality of subscribers (page 13, paragraph 0185). McCurdy does not disclose a method in which the navigation bar is inserted into the pages and stored as a part of the pages. However, Hearst discloses a

method in which an electronic book or magazine has a navigation bar inserted into it and stored as a part of the collection of pages which include at least one digital file, so that the navigation bar is viewable when viewing each of the pages (column 4, lines 6-60 of Hearst). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of McCurdy with the method of Hearst because it would have made the file more portable, allowing the navigation to be controlled by the document being viewed and not a specific browser.

Neither McCurdy nor Hearst disclose that single pages are laid out in a manner that fills a full-screen display. However, Berstis discloses a method in which a compound document may be selectively reflowed in order to fit a display screen or window (column 2, lines 20-64 of Berstis). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of McCurdy and Hearst with the teachings of Berstis because it would have improved the readability of the document based on the size of the display.

**Regarding dependent claims 17-22**, the claims incorporate substantially similar subject matter as claims 5-10. Thus, the claims are rejected along the same rationale as claims 5-10.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent Number 6,456,305

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC  
December 5, 2005

  
**STEPHEN HONG**  
SUPERVISORY PATENT EXAMINER